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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,503	07/16/2003	Arno Schmuck	07244-00142-US	8515
23416	7590	06/25/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			PAIK, STEVE S	
P O BOX 2207			ART UNIT	PAPER NUMBER
WILMINGTON, DE 19899			2876	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,503

Applicant(s)

SCHMUCK ET AL.

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Pre-Amendment filed July 16, 2003.

Information Disclosure Statement

2. The information disclosure statement filed October 9, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The copy of a Non-patent literature listed on the PTO-1449 is missing.

Drawings

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Specification

4. Applicant(s) are reminded to include the following in the next communication with respect to the header(s) within the specification, as following:

a) -- **Background of the Invention** --: The specification should set forth the Background of the Invention in two parts: -- **Field of the Invention** -- and -- **Description of the Related Art** --.

b) ____ -- **Brief Summary of the Invention** --.

c) ____ -- **Brief Description of the Several Views of the Drawing(s)** --.

d) ____ -- **Detailed Description of the Invention** --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoppe et al. (US 6,575,371).

Re claims 1, 2, 9 and 10, Hoppe discloses a card (Figs. 1-3) with a core (inlay 13) and at least one chip (module 17) incorporated into the core (inlay 13), characterised in that at least 5% of at least one main surface (protective layers 11 or 15) is covered by a seal (transparent foils), the chip (chip module 8) is covered on both main surfaces with a seal or a plastics layer and a recess (cavity; col. 3, ll. 52-57) of the core and/or a seal exhibit fine structures (Figs. 1-3). The seal (protective layers) extends at no point to the edge of the card.

Re claim 3, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein the core comprises paper or plastics-coated paper (col. 4, ll. 9-15).

Re claims 4-6, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein the core comprises at least one image-receiving layer/image forming layer (decorative layer 12 or 14) on at least one main surface. The image-receiving layer can be provided with various types of inscription properties that includes a very fine pore.

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Re claim 7, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein the image-forming layer comprises a photographic layer (col. 2, ll. 23-29).

Re claim 8, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein an image (graphical design) is arranged on the core.

Re claim 11, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein at least one seal (protective layers 11 or 15) covers the recess (cavity) for the chip (chip module 8) on at least one side.

Re claim 12, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein, the core (inlay 13) contains at least one recess (Fig. 2 and 3) with fine structure.

Re claim 13, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein, the chip (chip module 17) is accommodated in the recess (cavity in Fig. 3).

Re claim 14, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein at least one seal (protective layers 11 or 15) comprises fine structure.

Re claim 15, Hoppe discloses the card as recited in rejected claim 1 stated above, wherein the card is covered on at least one main surface at least over its entire area with a plastic layer (col. 3, ll. 4-14).

Re claim 17, Hoppe discloses a process of producing a card (Figs. 1-3) with a core (inlay 13) and at least one chip (module 17) incorporated in the core (inlay 13), characterised in that a recess (cavity) for the chip is created in the core, the chip is inserted once the recess has been covered on one side with a seal (protective layers 11 or 15) and then the opposite side of the recess is covered with a seal (protective layers 11 or 15) or a plastic layer, wherein a recess of the core and/or the seal exhibit fine structures (Figs. 1-3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe et al. (US 6,575,371) in view of Becker et al. (US 4,765,656).

Hoppe discloses the claimed features related to a card production.

Hoppe is, however, silent about how the different layers are joined together.

Becker discloses a data carrier card joined together by welding homogeneously to the same extent over the entire surfaces of the layers. The welding technique provides a strong adhesive force which prevent the layers from being separated easily. The strong bonding results in reducing any false modification to the contents of the card.

In view of Becker, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a welding technique in addition to the teachings of card manufacturing of Hoppe due to the fact that a durable and temper-resistant card can be produced for the purpose of improving the card usability. Furthermore, such modification of employing a welding technique to the teachings of Hoppe would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

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Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haghiri-Tehrani et al. (US 4,966,857) discloses a method of making an integrated circuit card; Tiffany, III (US 6,025,054) discloses a method of making a smart card; Hagner (US 5,830,561) discloses a card comprising at least one core layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven S. Paik
Examiner
Art Unit 2876

ssp